UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,920	10/24/2003	Gail Hegarty Fell	PANAMSAT-CONTINUATION	5346

33690 7590 03/02/2006

DAVID LOEWENSTEIN
802 KING ST.
RYE BROOK, NY 10573

EXAMINER	
EWART, JAMES D	

ART UNIT	PAPER NUMBER
2683	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/692,920	FELL ET AL.	
	Examiner	Art Unit	
	James D. Ewart	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

1. Claim 14 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 3 of prior U.S. Patent No. 6,674,994. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-13 and 15-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-7 of U.S. Patent No. 6,674,994. Although

the conflicting claims are not identical, they are not patentably distinct from each other because the instant application removed a limitation which made the parent application allowable and added a screen based interface which is common with most servers. The Examiner has found reference to reject the previously allowed limitation.

Information Disclosure Statement

3. The information disclosure statement is not in proper form. Please resubmit any references the Applicant wishes to be considered in the 1449 form with blank spaces for the Examiner to initial and sign.

Specification

4. The disclosure is objected to because of the following informalities: the preliminary amendment dated 24 October 2003 indicates that this application is a continuation of application 09/452,900, but is actually a continuation of application 09/452,500. Appropriate correction is required.

Drawings

5. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Objections

6. Claims 2,10,19 and 23 are objected to because of the following informalities: the claim states "transmitted/received to a provider" and should be "transmitted/received from a provider". Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. Claims 13 & 14 recites the limitation "the processor". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless – (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 2 - 6, 10 - 16, 20, and 21 - 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al. (U.S. Patent No. 5,920,701).

Referring to claims 1 and 9, Miller et al. discloses a file transfer, comprising: transmitting a file (Column 5, Line 19-23) using a satellite communications link (Column 1, Line 63) in accordance with a scheduling order created by a sender using a screen-based interface (Column 5, Lines 35-45) specifying pickup and delivery instructions for the file (Column 2, Lines 2-7). The Examiner equates the sender with the scheduler. The scheduler uses a screen-based interface.

Referring to claims 18 and 22, Miller et al. discloses a file reception, comprising: receiving a file (Column 5, Line 19-23) that has been transmitted using a satellite communications link (Column 1, Line 63) in accordance with a scheduling order created by a sender using a screen-based interface (Column 5, Lines 35-45) specifying pickup and delivery instructions for the file (Column 2, Lines 2-7). The Examiner equates the sender with the scheduler. The scheduler uses a screen-based interface.

Referring to claims 2,10,19 and 23, Miller et al further teaches, confirming that the file has been transmitted to a provider of the file (Column 3, Lines 8-11).

Referring to claims 3 and 11, Miller et al further teaches wherein the transmitting is simultaneously performed to selected destinations that are part of a predefined group / subscribers (Column 5, Lines 15-19) excluding some destinations in a geographic area (Column

4, Lines 35 -40). Geographic destinations excluded would be ones that do not have the replicated servers.

Referring to claim 4, Miller et al further discloses receiving the scheduling order from a user, the scheduling order also specifying at least one location (Column 11, Lines 7-26) and time for retrieval of the file (Column 2, Lines 2-7). Retrieval time is the completion time.

Referring to claim 5, Miller et al. further teaches checking facility availability in response to receiving the scheduling order (Column 2, Lines 11-44).

Referring to claim 6, Miller et al. further teaches sending a confirmation notice to the user after checking facility availability (Column 2, Lines 34-43).

Referring to claim 8 and 16, Miller et al. further teaches storing / buffering the file for a predetermined amount of time (Column 13, Lines 10-12). The file is stored until the scheduled time.

Referring to claim 12, Miller et al. further teaches a processor/scheduler for receiving the scheduling order from a user (Column 1, Lines 57-60 and Column 5, Lines 35-42), the scheduling order also specifying at least one location (Column 11, Lines 7-26) and time for retrieval of the file (Column 2, Lines 2-7).

Referring to claim 13, Miller et al. further teaches a processor/scheduler (Column 1, Lines 57-60 and Column 5, Lines 35-42) for checking facility availability in response to receiving the scheduling order (Column 2, Lines 11 – 44)

Referring to claim 17, Miller et al. teaches a user interface for scheduling a file transfer, comprising: a terminal for displaying a data screen to a sender (Column 5, Lines 36-48), the data screen including two or more of the following fields specifying a file location (Column 11, Lines 7-26), size (Column 2, Line 5), pickup time, payment type, confirmation type and delivery time (Column 2, Line 6), and means for sending information entered through the data screen to a central system (Column 5, Line 43 and Column 1, Lines 57 –60).

Referring to claims 20 and 24, Miller et al. further discloses wherein the file has been transmitted by multicasting (Column 1, Lines 64-66 and Column 2, Lines 56-59).

Referring to claims 21 and 25, Miller et al further teaches confirming availability of delivery according to the scheduling order, and wherein the confirming of availability occurs before the receiving of the file (Column 1, Line 57 to Column 2, Line 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al in further view of Huna (U.S. Patent No. 6,438,217).

Referring to claim 7 and 15, Miller et al. teaches the limitations of claims 7 and 15, but does not teach converting the format of the file. Huna teaches converting the format of the file (Column 4, Line 57). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Miller et al. with the art of Huna of converting the format of the file to provide compatibility with the receiving device (Column 4, Lines 56-58).

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al in further view of Krebs (U.S. Patent No. 6,557,320).

Referring to claim 14, Miller et al teaches a processor receiving the scheduling order, but does not teach sending a delivery notice to a destination for the file before transmitting the file. Krebs teaches sending a delivery notice to a destination for the file before transmitting the file (Figure 4 and Column 10, Lines 1-17). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Miller et al with the teaching of Krebs of sending a delivery notice to a destination for the file before transmitting the file to confirm the delivery time (Column 10, Lines 1-17).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bennington et al. U.S. Patent No. 6,373,528 discloses electronic television program guide schedule system and method.

Burns et al. U.S. Patent Publication No. 2001/0014103 discloses content provider for pull based intelligent caching system.

Carruthers et al. U.S. Patent Publication No. 2002/0128904 discloses method and system for scheduling online targeted content delivery.

Dillon et al. U.S. Patent No. 6,931,512 discloses method and apparatus for selectively retrieving information from a source computer using a terrestrial or satellite interface.

Fargher et al. U.S. Patent No. 5,586,021 discloses method and system for production planning.

Levy U.S. Patent No. 6,556,997 discloses information retrieval system.

Lilly et al. U.S. Patent No. 6,088,626 discloses method and apparatus for scheduling work orders in a manufacturing process.

Litteral et al. U.S. Patent No. 5,247,347 discloses pstn architecture for video-on-demand services.

Nishiyama et al. U.S. Patent No. 6,725,460 discloses multi-media data automatic delivery system.

Peterson et al. U.S. Patent No. 6,594,682 discloses client-side system for scheduling delivery of web content and locally managing the web content.

Ramot et al. U.S. Patent No. 5,815,566 discloses apparatus and method for dynamic inbound/outbound call management and for scheduling appointments.

Vincent U.S. Patent No. 4,881,179 discloses method for providing information security protocols to an electronic calendar.

Zhang et al. U.S. Patent No. 6,016,478 discloses scheduling system with methods for peer-to-peer scheduling of remote users.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D. Ewart whose telephone number is (571) 272-7864. The examiner can normally be reached on M-F 7am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571)272-7872. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2600.

Ewart
February 13, 2006

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600